UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,250	04/24/2000	Jonathan S. Goldick	MSFT-0174/150793.1	8456

41505 7590 05/24/2006	EXAMINER
WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)	PATEL, HARESH N

ONE LIBERTY PLACE - 46TH FLOOR	ART UNIT	PAPER NUMBER
PHILADELPHIA, PA 19103	2154	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Advisory Action ***Before the Filing of an Appeal Brief***	09/557,250	GOLDICK ET AL.
	Examiner	**Art Unit**	
	Haresh Patel	2154	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED <u>27 April 2006</u> FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

    a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

    b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

    (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

    (b) ☐ They raise the issue of new matter (see NOTE below);

    (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

    (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

        NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

    The status of the claim(s) is (or will be) as follows:

    Claim(s) allowed: *None*.

    Claim(s) objected to: *None*.

    Claim(s) rejected: *1-13,16-20 and 22-27*.

    Claim(s) withdrawn from consideration: *None*.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>See Continuation Sheet.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

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SUPERVISORY PATENT EXAMINER
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Continuation of 11. does NOT place the application in condition for allowance because:

the cited prior arts still render the claims unpatentable and the final rejection is deemed proper. Further, page 16, lines 13 – 25, of the specification of this application, very clearly states, "while the present invention has been described in connection with the preferred embodiments of the various figures, it is to be understood that other similar embodiments may be used or modifications and additions may be made to the described embodiment for performing the same function of the present invention without deviating therefrom. For example, while in a preferred embodiment, XML is used as a communications protocol for dependency information, it should be understood that many different communications and network protocols may be suited to the delivery of dependency information in accordance with the present invention. Furthermore, it should be emphasized that a variety of computer platforms, including handheld device operating systems and other application specific operating systems are contemplated. Therefore, the present invention should not be limited to any single embodiment, but rather considered in breadth and scope in accordance with the appended claims". Since, applicant's claims contain broadly claimed subject matter it clearly reads upon the examiner's interpretation of the claimed subject matter.

Applicant's arguments filed 4/27/2006, pages 6 to 8, have been fully considered but they are not persuasive. Therefore, rejection of claims 1-13, 16-20, and 22-27 is maintained.

Applicant argues (1), "Applicants submit that they have obviated the double patenting rejections (Lomet, U.S. Patent No. 5,946,698, 5,870,763, 6,067,550 and 5,530,800). Specifically, because the limitation of "an (API) for communications of application's state dependency information among applications" cannot be found in the art cited in the present Office Action, the current double patenting rejection should be withdrawn".
The examiner respectfully disagrees in response to applicant's arguments. Contrary to the applicant's assertions, the limitations of "an (API) for communications of application's state dependency information among applications" is not rejected by the single art. The rejection of the limitations "an (API) for communications of application's state dependency information among applications" is made using the combine teachings of the above-mentioned respective patent of the double patent rejection with the teachings of the Van Huben et al., 5,920,873, IBM (Hereinafter Van-IBM) which discloses the well-known concept of using application programming interface, API (e.g., paragraph 787) and the teachings of the Daminin et al., 5,938,775, AT&T (Hereinafter Damani-AT&T) which discloses the concept of handling dependency among applications (e.g., usage of transitive dependency tracking, abstract). With the teachings of Van-IBM and Damani-AT&T it would be obvious to one of ordinary skill in the art to include concept of using API and dependency among applications with the claimed subject matter of claims 1-39 of Lomet, U.S. Patent No. 5,946,698. Note: The API is a set of routines used by an application program to direct the performance of procedures by the computer's operating system and the concept of API is used to implement functionality. Since, the "communications of application's state dependency information among applications", which is taught by the above-mentioned arts needs to implemented by routines or relative software entities, The well-known concept of the API would help the implementation. Hence, the rejection is maintained.

Applicant argues (2), "the cited references do not teach or disclose the limitations an API for communications of application's state dependency information among applications", "there is no motivation to combine the APIs from the Van Huben et al. reference with the teachings of Lomet as such a combination does not make any technological sence and such a combination would destroy the intended functionality of the claimed subject matter" "the applicant's disagree that API have to be embedded in object tables and a field is not a substitute for an API in the context discussed above" and
states " The Lomet reference merely discloses an aspect of the disclosure that optimizes the application read operation to avoid writing the object data read to the log record. The read optimizing technique eliminates posting the read values to the log by substituting, for the read values, an identity of the location from where the values are read and posting the identity instead of the values. Moreover, Lomet discloses a cache manager that has an object table wltich tracks the objects maintained in a volatile cache. The object table includes field to track dependencies among the objects".

The examiner respectfully disagrees in response to applicant's arguments. As asserted by the applicant that the teachings of the Lomet are limited to "the disclosure that optimizes the application read operation to avoid writing the object data read to the log record. The read optimizing technique eliminates posting the read values to the log by substituting, for the read values, an identity of the location from where the values are read and posting the identity instead of the values. Moreover, Lomet discloses a cache manager that has an object table wltich tracks the objects maintained in a volatile cache. The object table includes field to track dependencies among the objects", is incorrect. Lomet also teaches a method for utilizing application's state dependency information (e.g., col., 6, lines 41 – 58) to efficiently perform a backup service operation (e.g., col., 7, lines 6 – 26) in a computer system (e.g., col. 5, lines 31 – 46), registering applications (e.g., col., 6, lines 3 – 26) loaded in said computer system (e.g., col. 5, lines 31 – 46) with a software module (e.g., col., 34, lines 21 – 47) for communications of application's state dependency (e.g., col., 6, lines 41 – 58) information among objects (e.g., col., 6, lines 32 – 45), a common software agent (e.g., col., 5, lines 60 – 67), a storage component (e.g., col., 6, lines 41 – 56) utilized by said agent (e.g., col., 5, lines 60 – 67) and a backup service (e.g., col., 5, lines 40 – 51), storing in said storage component (e.g., col., 6, lines 41 – 56) at least one application's state dependency information (e.g., col., 6, lines 41 – 58) communicating said at least one application's state dependency information (e.g., col., 6, lines 41 – 58) from said storage component (e.g., col., 6, lines 41 – 56) to said backup service (e.g., col., 5, lines 40 – 51), etc. Van-IBM discloses the well-known concept of using application programming interface, API (e.g., paragraph col., 114, line 5 – col., 115, line 17).

The applicant's assertion that "there is no motivation to combine the APIs from the Van Huben et al. reference with the teachings of Lomet as such a combination does not make any   technological sence and such a combination would destroy the

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intended functionality of the claimed subject matter" is incorrect. To make it more clearer the API is a set of routines used by an application program to direct the performance of procedures by the computer's operating system and the concept of API is used to implement functionality. Since, the "communications of application's state dependency information among applications", which is taught by the above-mentioned arts needs to implemented by routines or relative software entities, The well-known concept of the API which also taught by the above-cited referencs would help the implementation. Hence, the applicant's assertion that the combination does not make any technological sence and such a combination would destroy the intended functionality of the claimed subject matter is just misleading. The teachings of the functionality of the Lomet and the cited refecences needs to be implemented and the well-known usage of the API would support the implemention. Hence, rather destroying the intended functionality as asserted by the application the API would infact support the implementation.

The statement "the applicant's disagree that API have to be embedded in object tables and a field is not a substitute for an API in the context discussed above" is misleading. The procecution history is very clear that no one has claimed or suggested that API have to be embedded in object tables and a field is a substitute for an API. To combine the teachings of the cited references as mentioned above, there is no requirement for API have to be embedded in object tables and a field is a substitute for an API. Further, please see the claimed invention (especially claim 1) which is not limited to using API that is embedded or using object tables or using filed as a substitute for an API, etc. Infact, the claimed invention does not include limitations that reflect how the implementation of the claimed subject matter is different than the Lomet cited arts. The Lomet cited art teachings are not limited to the applicant's assertions, hence the rejection is maintained.

Applicant argues (3), "the recited API is configured to (1) perform registering applications loaded in a computer system, and it is utilized for communications of application's state dependency information among applications, (2) enable an agent to collect, store, and package information about state dependencies among applications, and (3) maintain communications protocols to which the agent accords to. Applicants submit that such an API cannot be found in the cited art (Lomet, 5,870,763)".

The examiner respectfully disagrees in response to applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies, "the recited API is configured to (1) perform registering applications loaded in a computer system, and it is utilized for communications of application's state dependency information among applications, (2) enable an agent to collect, store, and package information about state dependencies among applications, and (3) maintain communications protocols to which the agent accords to. Applicants submit that such an API cannot be found in the cited art", are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The First inquiry must be into exactly what the claims define. See In re Wilder, 166 USPQ 545, 548 (CCPA 1970).

What is claimed is, please see claim 1, which is related to these limitations, "the method comprising acts of: registering applications loaded in said computer system with an application dependency application programming interface (API) for communications of application's state dependency information among applications, a common software agent, a storage component utilized by said agent and a backup service", "wherein, said API (note: API is not necessarily configured to perform all the tasks and/or the tasks handled only by itself) enables an agent to collect, store and package information about state dependencies among applications in response to a request by a service, please see claim 16, which is related to these limitations; and, "an agent that functions according to communication protocols of an application programming interface (API) is said system for processing said dependency information, please see claim 16, which is related to these limitations. Please refer to the below rejections of this office action to the amended claimed limitations of the claims. Further, page 16, lines 13 – 25, of the specification of this application, very clearly states, "while the present invention has been described in connection with the preferred embodiments of the various figures, it is to be understood that other similar embodiments may be used or modifications and additions may be made to the described embodiment for performing the same function of the present invention without deviating therefrom. For example, while in a preferred embodiment, XML is used ms a communications protocol for dependency information, it should be understood that many different communications and network protocols may be suited to the delivery of dependency information in accordance with the present invention. Furthermore, it should be emphasized that a variety of computer platforms, including handheld device operating systems and other application specific operating systems are contemplated. Therefore, the present invention should not be limited to any single embodiment, but rather considered in breadth and scope in accordance with the appended claims". Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.

Applicant argues (4), "In short, Van Huben et al., 5,920,873, IBM (Hereinafter Van-IBM) despite its mention of certain kinds of APIs, does not disclose the kinds APIs that are recited in claims 1, 16, and 22: APIs configured to (1) perform registering applications loaded in a computer system, and utilization for communications of application's state dependency information among applications, (2) enablement of an agent to collect, store, and package information about state dependencies among applications, and (3) maintenance of communications protocols to which the agent accords to", and "None of the other references, Damani et al. or Lewis, or the Official Notice are cited for disclosing such APIs, and none of the references disclose such recited APIs. Therefore, the independent claims patentably define over the cited art either for nonobviousness rejection purposes or double patenting rejection purposes".

The examiner respectfully disagrees in response to applicant's arguments. Contrary, to applicant's assertions, "the kinds of APIs that are recited in claims 1, 16, and 22: APIs configured to 1) perform ..., utilization for ..., 2) enablement of ..., 3) maintenance of ...,", only one (single for all three acts) API is claimed in each claim and which is neither configured for performing nor configured for utilization or enablement or maintenance, etc., please see claims 1, 16 and 22. In response to "Van-IBM does not disclose the above limitations" and "None of the other references, Daminin et al., 5,938,775, AT&T (Hereinafter Damani-AT&T) or Lewis, or the Official Notice are cited for disclosing such APIs, and none of the references disclose such recited APIs", i.e., in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). At this point, the limitations are not rejected using the Lomet et al. 5,870,763 (Hereinafter Lomet) reference and not the Van-IBM reference.

The applicant concerned limitations are rejected using combined teachings of the above-mentioned references. Also, contrary to applicant's assertions, one skilled in the art, very well recognizes the usage of an application programming interface (API) and

that API is a routine or set of routines used by an application program to direct the performance of procedures by the computer's operating system. Please refer to the below rejections of this office action (combined teachings of the cited arts) to the amended claimed limitations of the claims (along with the teachings of the cited arts). Further, page 16, lines 13 – 25, of the specification of this application, very clearly states, "while the present invention has been described in connection with the preferred embodiments of the various figures, it is to be understood that other similar embodiments may be used or modifications and additions may be made to the described embodiment for performing the same function of the present invention without deviating therefrom. For example, while in a preferred embodiment, XML is used ms a communications protocol for dependency information, it should be understood that many different communications and network protocols may be suited to the delivery of dependency information in accordance with the present invention. Furthermore, it should be emphasized that a variety of computer platforms, including handheld device operating systems and other application specific operating systems are contemplated. Therefore, the present invention should not be limited to any single embodiment, but rather considered in breadth and scope in accordance with the appended claims". Since, applicant's claims contain broadly claimed subject matter, it clearly reads upon the examiner's interpretation of the claimed subject matter. Therefore, the rejection is maintained.